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AMD

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DATE: February 21, 2003 **MATTER NUMBER:** 09807811

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Examiner A. Decloux USPTO, Group 1644	703-746-4982	

FROM: Norman Hanson **USER ID:** NH01030 **FLOOR:** 24

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RE: LUD 5466.4

NUMBER OF PAGES WITH COVER PAGE: 5

Message:

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LUD 5466.4 CIP – NDH (09807811) #44 2nd

VIA FACSIMILE

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office on February 21, 2003.

FULBRIGHT & JAWORSKI LLP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s)	:	Alexander, et al.
Serial No	:	09/165,546
Filed	:	October 2, 1998
For	:	ISOLATED PEPTIDES CORRESPONDING TO AMINO ACID SEQUENCES OF NY-ESO-1...
Art Unit	:	1644
Examiner	:	A. Decloux

February 21, 2003

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

LETTER

This is submitted in response to the Advisory Action, dated January 24, 2003. It also responds to

(1) the telephone conversation between the examiner and the undersigned which took place on February 3;

(2) a telephone message left by the examiner on the undersigned's answering machine, on February 13, and;

(3) a telephone conversation initiated by the examiner on February 20.

The facts are the following. The January 24 advisory action incorrectly states that claims 84 & 95 are duplicates. Further, the advisory action blatantly misrepresents the facts of prior prosecution.

With respect to the latter, the examiner states, in the January 24 advisory action:

> "Thus, said claims, (i.e., claims 89-91 and 95) were also not indicated as allowable by the examiner in Paper Number 40."

Attached is a copy of paper number 38. Please note box 4:

> "Newly proposed or amended claim(s) 89-91 and 95 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claims."

In paper number 40, the examiner changed her position on this. Hence, to take the position now that the examiner never said this is blatantly wrong. It is not the first time, however, that the examiner has done this.

With respect to the contention that claims 84 & 95 are the same, they are not. Applicants' representative called the examiner, on Friday, January 31, and pointed out that the claims recited different sequences. The undersigned left a message for the examiner, advising her of this, and specifically asking if anything was required.

On February 3, the examiner called back, admitted the error, and advised the undersigned - when he asked again - that applicants did not need to take care of anything – she would "take care of it right away."

Ten days later, when applicants had heard nothing, their representative telephoned and left a message for the examiner. He received a phone message the next day, which stated in part "you should know that we have to do things like a sequence search and an interference search. You'll hear from us when we're done."

On February 20, the examiner called, and advised the undersigned "the ball is in your court. You have to file something, and you need a one month extension of time."

More than 2 weeks after the examiner advised that nothing was due, she now advises that it is – and applicants are supposed to pay for the examiner's error! Indeed they are expected to pay for the examiner's errors, in that she misread claims and SEQ ID numbers (which easily distinguish claims 84 & 95), and erred in stating that nothing was required.

Why should applicants pay for extensions? The examiner admits, in paper number 41, that the file was lost for 4 months, that the PTO lost amendments, and that she gave applicants incorrect information as to when papers were due.

The examiner's response should include a complete explanation of these improprieties, or applicants will take the matter up with the appropriate officials in the Commissioner's office.

LUD 5466.4 CIP - JEL/NDH

Allowance of this application is expected, and if is not forthcoming in 10 days, appropriate officials will be contacted.

Respectfully submitted,

FULBRIGHT & JAWORSKI, L.L.P.

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4:53 PM 2/21/03 Transmission Record
Received from remote ID "212 318 3788"
Unique ID: "ADE3E565991017A"
Elapsed time: 1 minutes, 44 seconds.
Used channel 4.
No ANI data.
No AOC data.
Resulting status code (0): No Errors
Pages sent: 1 - 5